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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/672,049	09/29/2000	Johannes Platzek	SCH-1722	2997

23599 7590 11/19/2001

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EXAMINER

WELLS, LAUREN Q

ART UNIT	PAPER NUMBER
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1619

DATE MAILED: 11/19/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Long

Office Action Summary

Application No.

09/672,049

Applicant(s)

PLATZEK ET AL.

Examiner

Lauren Q Wells

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-38 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claims 1-38 are pending. Claims 1-38 were amended per the Preliminary Amendment received September 6, 2001, Paper No. 5.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-6, 20, 27-29, drawn to galenical formulations of paramagnetic perfluoroalkyl-containing compounds of formula $Rf-A$, wherein A is a metal complex classified in class 424, subclass 9.6.
- II. Claims 1, 4-5 and 7-10, drawn to perfluoroalkyl-containing compounds, wherein A comprises metal complexes of polycarboxylic acids classified in class 560, subclass 190.
- III. Claims 1, 4-5, 11-16 and 21, drawn to perfluoroalkyl-containing compounds, wherein A comprises metal complexes of twelve-membered rings with 4 hetero-nitrogen atoms further comprising metals, classified in class 540, subclass 465.
- IV. Claims 1, 4-5 and 17-18, drawn to perfluoroalkyl-containing compounds, wherein A comprises metal complexes metal complexes of six-membered rings with 2 hetero-nitrogen atoms, classified in class 544, subclass 225.
- V. Claims 1, 4 and 19, drawn to perfluoroalkyl-containing compounds, wherein A comprises twelve-membered rings with 4 hetero-nitrogen atoms, classified in class 540, subclass 474.
- VI. Claims 1 and 23-25, drawn to perfluoroalkyl-containing compounds comprising hydrophilic groups, classified in class 568, subclass 700.

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- VII. Claims 1 and 26, drawn to perfluoroalkyl-containing compounds comprising carbocyclic compounds, classified in class 514, subclass 765.
- VIII. Claim 30, drawn to a compound comprising a perfluoroalkyl radical, classified in class 570, subclass 101.
- IX. Claim 31, drawn to a conjugate of cyclodextrin and perfluoroalkyl-containing compounds, classified in class 536, subclass 1.
- X. Claims 1 and 32-36, drawn to a method of making galenical formulations, classified in class 424, subclass 9.6.
- XI. Claims 1 and 37-38, drawn to a method of using galenical formulations, classified in class 424, subclass 9.6.

The inventions are distinct, each from the other because of the following reasons:

Inventions of Groups I-IX are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are directed toward perfluoroalkyl-containing compounds of varying chemical structure. The differences in chemical structure results in chemical behavior differences, thus rendering the inventions unrelated.

Inventions of Groups X and XI are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process can be used to make emulsions or warmed aqueous food products.

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, paramagnetic perfluoroalkyl-containing substances, diamagnetic perfluoroalkyl-containing substances, and a process for producing galenical formulations are generic.

Note: If a chemical formula is elected for the perfluoroalkyl-containing substances, each variable of the formula must be defined.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the

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examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

As a result of the complexity of the chemical structures, a telephone restriction/election of species was not feasible.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on T-F (6-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana L Dudash can be reached on (703) 308-2328. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw
November 2, 2001


DAMERON L. JONES
PRIMARY EXAMINER